

Application Serial No. 09/838,821
Amendment dated May 31, 2005
Response to Office Communication of February 28, 2005

REMARKS

1) **Examiners Interview**

Applicants thank Examiner Robinson for her kind assistance, particularly during the Examiner's Interview of February 18, 2005. Responsive to the discussions at that interview, a Terminal Disclaimer and missing reference copies were provided to the Examiner by a communication mailed March 22, 2005. In accord with discussion at this interview, Applicants assert the pending claims are in condition for allowance. Early notice of such allowance is requested.

To provide a more complete record of response to the Examiner's action dated May 25, 2003, the rejections and replies are discussed below.

2) **Continuity Data**

The pending application is a divisional application of application Serial No. 09/345,815, filed June 30, 1999, and claims the benefit of priority to provisional application Serial No. 60/091,150, filed June 30, 1998. An amendment to the specification as required by the Examiner was submitted on May 30, 2001. Accordingly, Applicants assert priority claim is properly recorded in the specification and of record.

3) **Information Disclosure Statement**

In the 2003 Office Action, the Examiner had requested copies of references noted in the submitted Information Disclosure Statement. Examiner Robinson clarified by telephone that specific references were missing from the parent file and that copies were needed for the instant application. Copies of the needed references were mailed to the U.S. Patent and Trademark Office on March 22, 2005.

4) **Duplicative Claims 4, 5**

Claims 4 and 5 were cancelled in the Amendment dated September 20, 2004, rendering this rejection moot.

Application Serial No. 09/838,821

Amendment dated May 31, 2005

Response to Office Communication of February 28, 2005

5) Indefiniteness Rejections

The claims amended in the Reply dated September 20, 2004, were acknowledged by the Examiner during the Examiner's interview to overcome these rejections.

6) Non-Statutory Double Patenting

The pending divisional claims were rejected as obvious over the issued parent claims of U.S. Patent Application Serial No. 09/345,915, now U.S. Patent No. 6,800,649 B1, dated October 5, 2004. Applicants' dispute the propriety of a double patenting rejection for subject matter asserted by the Examiner to be patentable distinct by the Restriction Requirement dated May 23, 2003.

7) Terminal Disclaimer

Applicants have submitted a Terminal Disclaimer in the Communication dated March 22, 2005, to speed allowance of the claims. The Examiner is requested to reconsider the necessity of the Terminal Disclaimer in view of the amended claims. If the Terminal Disclaimer is no longer required, Applicants request it be rescinded.

8) Anticipation

The instant claims are drawn to a method for inhibiting activation of c-jun in mammalian or avian cells by contacting the cells with an inhibitor of JAK-3. The cited reference fails to disclose such a method.

The PCT application of Ihle cited by the Examiner (WO95/03701) discloses activation of JAK-1, 2, and 3 by specific cytokines. The reference fails to disclose or suggest a role for JAK-3 in the activation of c-jun, or that an inhibitor of JAK-3 would be useful to inhibit the activation of the protooncogene, c-jun.

The cited reference discloses specific cytokines that induce phosphorylation of specific JAKs. For example, at page 20, the specification discloses that IL-2 and IL-4 induce phosphorylation of JAK-3, but not of JAK-2, and that EPO induces phosphorylation of JAK-2, but not JAK-3. At page 119 the authors state: "In a series of IL-3 dependent myeloid cell lines, no constitutive or inducible tyrosine phosphorylation of Jak3 was seen with EPO, IL-3, GM-

Application Serial No. 09/838,821

Amendment dated May 31, 2005

Response to Office Communication of February 28, 2005

CSF, G-CSF, IFN-alpha, IFN-gamma, or IL-6. However Jak3 was tyrosine phosphorylated in IL-2 or IL-4 stimulated CTLL cells."

In contrast, the present specification demonstrates expression of the protooncogene c-jun is inhibited in cells treated with an inhibitor of JAK-3. See, for example, Figure 5. For at least these reasons, the Applicants assert the cited reference fails to anticipate the claimed invention, and requests removal of this rejection.

9) Obviousness

The Examiner has asserted the original claims 1, 4, 5, and 9-13 are obvious in view of Ihle (WO 95/03701), discussed above, taken with Narla 1998 and Chae 1993. Applicants respectfully traverse this rejection.

The primary reference is cited as teaching a method to inhibit JAK-3. As discussed above, the primary reference fails to teach or suggest a method for inhibiting the protooncogene, c-jun, using an inhibitor of JAK-3. The secondary references do not cure the deficiencies of the primary reference.

Narla 1988 is cited for disclosing inhibition of EGF-R tyrosine kinase. Chae 1993 is cited for disclosing that protein kinase activation precedes radiating induced activation of c-jun expression. The cited combination, however, fails to teach or suggest the claimed method, inhibition of the specific protooncogene, c-jun, by inhibiting the specific JAK, JAK-3. No suggestion of this specific combination is found in the cited art, which admits of differences in the regulation and effects of the different JAKS, as discussed above.

For at least the reasons discussed above, Applications assert the claims are not obvious in view of the cited art, and the rejections should be removed.

Application Serial No. 09/838,821
Amendment dated May 31, 2005
Response to Office Communication of February 28, 2005

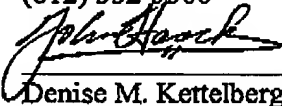
In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date:

May 31, 2005


Denise M. Kettelberger
Reg. No. 33,924

John L. Heack
Reg. No. 36,154
for DMK

23552

PATENT TRADEMARK OFFICE

BEST AVAILABLE COPY